

Research and Development Corp. (collectively “Dentsply”), for willful infringement. Sanctions are once again warranted.

There is no question that a discovery violation occurred. Testimony by Mr. Chen, the inventor of the allegedly infringing process, is material to Dentsply’s claims of willful infringement and information relating to his whereabouts clearly fell within the required disclosures of Federal Rule of Civil Procedure 26. See FED. R. CIV. P. 26(a)(1)(A). Although Mr. Chen left Hu-Friedy’s employ in March 2003, other employees of the company had been in contact with Mr. Chen within the last year and knew how to reach him. Yet, this information was not provided to counsel for plaintiffs. To the contrary, counsel for plaintiffs were told that Hu-Friedy did not have any information concerning Mr. Chen’s current whereabouts. The disclosure to Dentsply was not merely incomplete; it was materially incorrect.

Hu-Friedy offers no reasonable justification for this discovery violation. It complains that Dentsply did not “press” for information relating to Mr. Chen; however, the obligation to supplement incomplete disclosures is neither incumbent upon nor tempered by the stridency of the opposing party’s requests. See id. 26(a)(1), (e)(1). It asserts that Dentsply could have discovered the information through its own devices; however, the duty to disclose applies even if the other party enjoys alternative means of access to the information at issue. See, e.g., 8 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 2014 (3d ed. 2002). It argues that its error was merely negligent, not deliberate; however, this fact merely lessens Hu-Friedy’s culpability without excusing its omission. See, e.g.,

Tolerico v. Home Depot, 205 F.R.D. 169, 175-76 (M.D. Pa. 2002). In short, none of the explanations presented by Hu-Friedy justify the failure to disclose.

Sanctions are clearly warranted to reprimand Hu-Friedy and to return Dentsply to approximately the same litigation position that it would have occupied absent the discovery violation. See, e.g., Quinn v. Consol. Freightways of Del., 283 F.3d 572, 576 (3d Cir. 2002). These results may be best achieved by deeming Dentsply as a matter of law to have offered conclusive evidence of “willfulness” for purposes of its willful infringement claim. Mr. Chen was the primary force behind development of the Hu-Friedy device, and his testimony arguably could have established that the device represented willful copying of the Dentsply patent. Hu-Friedy should not be allowed to benefit from the withholding of this information—even if its actions were unintentional—to avoid a finding of willfulness. This sanction recognizes the seriousness of the violation without foreclosing Hu-Friedy’s defense to infringement *imprimis*.²

The court will also direct Hu-Friedy to compensate Dentsply for reasonable expenses, including attorney’s fees, caused by the failure to disclose. See FED. R. CIV. P. 37(c). These expenses clearly include preparation of the motion for sanctions and supporting briefs, and may also encompass other costs causally

² The court has considered the alternative sanctions proposed by Dentsply, including a finding of partial equivalence and the entry of default judgment, but rejects these as excessive in light of the nature of the discovery violation and its limited effect on Dentsply’s case-in-chief. See, e.g., Poulis v. State Farm Fire & Cas. Co., 747 F.2d 863, 868 (3d Cir. 1984).

linked to the late disclosure. See id. Dentsply will be directed to file an affidavit detailing expenses for which it claims compensation, and Hu-Friedy will be permitted to raise objections to those expenses if appropriate. The court will finally resolve the expenses to be assessed in a subsequent order.

An appropriate order will issue.

S/ Christopher C. Conner
CHRISTOPHER C. CONNER
United States District Judge

Dated: June 13, 2005

- IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF PENNSYLVANIA**

2. The parties shall file post-trial briefs and proposed findings of fact and conclusions of law that address issues relevant to disposition of the above-captioned case and that include references to the evidentiary record.
 - a. The parties shall file supporting post-trial briefs and proposed findings of fact and conclusions of law on or before July 5, 2005.
 - b. The parties shall file responsive post-trial briefs and findings of fact and conclusions of law on or before July 19, 2005.

S/ Christopher C. Conner
CHRISTOPHER C. CONNER
United States District Judge